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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,274	09/21/2000	Ira Richard Forman	AUS9-2000-0492-US1	8429

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EXAMINER

ENG, DAVID Y

ART UNIT

PAPER NUMBER

2155

DATE MAILED: 03/01/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,274

Applicant(s)

FORMAN ET AL.

Examiner

DAVID Y. ENG

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: ____ |

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The legends in the drawings are not legible.

Claims 2-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, there are no clear anticipate basis for steps a, b and c.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-28 are rejected under 35 U.S.C. 102(a) as being anticipated by Greenstein (USP 6,266,692).

See the abstract, claims 1-16 and Figure 1 in Greenstein. Greenstein teaches a method for screening electronic messages (see the title of Greenstein and “filtering electronic mail” in abstract), comprising the steps of:

Determining (see “filtering – electronic mail – for a valid passcode” in abstract), for a designated receiver for a first electronic message from a sender, whether the electronic message includes a pass from the receiver;

Forwarding the first electronic message to the receiver, responsive to the message having the pass (see lines 6-7 of abstract); and

Generating a notice to the sender, responsive to the message not having the pass (see claims 7 and 8), including information requesting the sender to return (the passcode), to an indicated address, a pass for the first electronic message.

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For dependent claims, see claims 2-16 in Greenstein.

Claims 1-28 are rejected under 35 U.S.C. 102(a) as being anticipated by Haruhisa. ^(IDS)

See at least the abstract and Figure 5, step S1435 in Haruhisa. Haruhisa teaches a method for screening electronic messages (see the title and abstract in Haruhisa), comprising the steps of:

Determining (see the steps in Figure 5), for a designated receiver for a first electronic message from a sender, whether the electronic message includes a pass from the receiver;

Forwarding the first electronic message to the receiver, responsive to the message having the pass (see step S1437 in Figure 5).

Generating a notice to the sender, responsive to the message not having the pass, including information requesting the sender to return (see Step S1435 "challenge/response authentication in Figure 5), to an indicated address, a pass for the first electronic message.

As to claims 2-7, e-mail, attachment and web page are all well-known communication tools. See Figures 1-4.

Claims 8-28 did not define above the invention claimed in claims 1-7 and are therefore rejected under Haruhisa for the same reasons set forth in the rejections of claims 1-7 above.



DAVID Y. ENG
PRIMARY EXAMINER